

**SCHIFF HARDIN LLP**

PATENT DEPARTMENT

6600 SEARS TOWER

233 SOUTH WACKER DRIVE

CHICAGO, ILLINOIS 60606

S GROUP ART UNIT: 3739

RE APPLICATION OF:

Graumann et al

SERIAL NO.:

10/615,527

EXAMINER: James M. Kish

FILED:

July 8, 2003

CONFIRMATION NO.: 8192

TITLE: MEDICAL APPARATUS FOR TRACKING MOVEMENT OF A BONE FRAGMENT IN A DISPLAYED IMAGE

**APPLICANTS' RESPONSE TO AUGUST 9, 2006 OFFICE ACTION****MAIL STOP AMENDMENT**

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

SIR:

Transmitted herewith is an amendment in the above-identified application.

☒ No additional fee is required.

The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	*17	MINUS	**20	X 18	( ) X 25.00 ( ) X 50.00	
INDEP. CLAIMS	*2	MINUS	3	X	( ) X 100.00 ( ) X 200.00	
Application amended to contain any multiple dependent claims not previously paid for.				( ) YES ( ) NO	( ) \$180.00 ( ) \$360.00 ONE TIME	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$00

\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20 write "20" in this space.

☐ Applicants petition the Commissioner of Patents and Trademarks to extend this time for response to the Office Action dated \_\_\_\_\_ for \_\_\_\_\_ month so that the period for response is extended to \_\_\_\_\_. A check in the amount of \$ \_\_\_\_\_ is attached to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to deposit account No. 501519. A duplicate copy of this sheet is enclosed.

☐ A check in the amount of \$ \_\_\_\_\_ is attached.

☐ A check for \$ \_\_\_\_\_ accompanying IDS under 37 CFR 1.97(c) is attached

☐ A check for \$ \_\_\_\_\_ and Petition for Consideration of IDS under 37 CFR 1.97(d) is attached.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519. A duplicate of this sheet is enclosed.

When phoning re this application, please call (312) 258-5500.

SCHIFF HARDIN LLP (Customer Number: 26574)

BY Steven H. Noll (28,982)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on November 8, 2006.

Steven H. Noll

NAME OF APPLICANT'S ATTORNEY

Steven H. Noll

SIGNATURE

November 8, 2006

DATE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPLICANTS' RESPONSE TO THE AUGUST 9, 2006 OFFICE ACTION**

APPLICANTS: Graumann et al. CONFIRMATION NO.: 8192  
SERIAL NO.: 10/615,527 GROUP ART UNIT: 3739  
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TITLE: MEDICAL APPARATUS FOR TRACKING MOVEMENT OF A  
BONE FRAGMENT IN A DISPLAYED IMAGE

**MAIL STOP AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

S I R:

Applicants and their counsel have carefully reviewed the Office Action dated August 9, 2006, but believe the claims in their present form are patentable over the teachings of the references relied upon by the Examiner. Reconsideration of the application in view of the following arguments in support of patentability is therefore respectfully requested.

**REMARKS**

In the Office Action dated August 9, 2006, claims 1-4, 6-13, 16 and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Foley et al. This rejection is respectfully traversed for the following reasons.

In substantiating this rejection, the Examiner made no mention whatsoever of a disclosure in the Foley et al. reference regarding a medical instrument adapted for introduction into the body of a subject that is adapted to interact with a bone fragment in the body of the subject to move the bone fragment, nor did the Examiner identify any disclosure in the Foley et al. reference regarding an image computer